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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,181	09/23/2004	Swindell Allen Grimsley	PP/3-22330/A/CGC 2113/PCT	7342
324	7590	06/23/2006	EXAMINER	
CIBA SPECIALTY CHEMICALS CORPORATION PATENT DEPARTMENT 540 WHITE PLAINS RD P O BOX 2005 TARRYTOWN, NY 10591-9005			CORDRAY, DENNIS R	
			ART UNIT	PAPER NUMBER
			1731	
DATE MAILED: 06/23/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/509,181	GRIMSLEY ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Dennis Cordray	1731	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### **Status**

1) Responsive to communication(s) filed on 12 May 2006.

2a) This action is **FINAL**.                    2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### **Disposition of Claims**

4) Claim(s) 1-17 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-17 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### **Application Papers**

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### **Priority under 35 U.S.C. § 119**

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### **Attachment(s)**

1) Notice of References Cited (PTO-892)  
 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)  
 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
 Paper No(s)/Mail Date \_\_\_\_\_

4) Interview Summary (PTO-413)  
 Paper No(s)/Mail Date. \_\_\_\_\_

5) Notice of Informal Patent Application (PTO-152)  
 6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 1-10 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Langley et al (4753710) or Langley et al (4913775).

Langley et al ('710) discloses a process for making paper comprising:

- a).adding to the paper stock a cationic polymer followed by addition of
- b) anionic bentonite clay microparticles (at least 90% below 100 microns)

(Abstract; col 10, lines 47-49; col 10, lines 36-40; col 11, lines 3-5).

The papermaking stock can contain recycled or waste pulp (col 8, lines 8-14).

The cationic polymer has a molecular weight of at least 500,000 (col 8, lines 40-41).

The polymer can comprise one or more of cationic monomers of diallyldimethyl ammonium chloride, dialkylaminoalkyl-(meth)acrylates or -(meth)acrylamides or quaternary ammonium salts thereof, polyethyleneimines, or polyamine epichlorohydrin.

The polymer can be copolymerized with acrylamide monomers (col 8, lines 46-64). If monomers other than cationic monomers are used, the cationic monomers are preferably present at greater than 10% (col 9, lines 9-17). The bentonite is defined to include anionic swelling clays such as montmorillonite and Fullers Earth (col 10, lines 47-54). Langley et al teaches that it is common to add inorganic materials such as

bentonite and alum as well as natural or synthetic polymers to the stock for pitch control (col 1, lines 31-36). The cationic polymer is added in an amount from 0.03 to 0.5% based on the dry weight of the paper (col 9, lines 18-22 and 38-55), which overlaps the range used in Examples 1 and 2 on p 9 of the instant Specification. The bentonite is added in an amount from 0.03 to 0.5% (col 10, lines 44-46), which lies within the range disclosed on p 7, 2<sup>nd</sup> par from bottom of the instant Specification.

The cationic polymer and bentonite disclosed by Langley et al ('710), when added to the suspension, are capable of reducing the deposition of white pitch because, where the claimed and prior art apparatus or product are identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

2. Langley et al ('775) discloses a process for making paper comprising:

- a).adding to the paper stock a cationic polymer followed by addition of
- b) anionic bentonite clay microparticles (at least 90% below 100 microns)  
(Abstract; col 10, lines 59-63; col 11, lines 3-5; col 11, lines 27-28).

The papermaking stock can contain recycled or waste pulp (col 8, lines 14-19).

The cationic polymer has a molecular weight of at least 500,000 (col 8, lines 46-47).

The polymer can comprise one or more of cationic monomers of diallyldimethyl

ammonium chloride, dialkylaminoalkyl-(meth)acrylates or -(meth)acrylamides or quaternary ammonium salts thereof, polyethyleneimines, or polyamine epichlorohydrin. The polymer can be copolymerized with acrylamide monomers (col 8, lines 52-67; col 9, lines 1-2). If monomers other than cationic monomers are used, the cationic monomers are preferably present at greater than 10% (col 9, lines 19-26). The bentonite is defined to include anionic swelling clays such as montmorillonite and Fullers Earth (col 11, lines 3-10). Langley et al teaches that it is common to add inorganic materials such as bentonite and alum as well as natural or synthetic polymers to the stock for pitch control (col 1, lines 34-39). The cationic polymer is added in an amount from 0.03 to 0.5% based on the dry weight of the paper (col 9, lines 26-30 and 50-67), which overlaps the range used in Examples 1 and 2 on p 9 of the instant Specification. The bentonite is added in an amount from 0.03 to 0.5% (col 10, lines 66-67), which lies within the range disclosed on p 7, 2<sup>nd</sup> par from bottom of the instant Specification.

The cationic polymer and bentonite disclosed by Langley et al ('775), when added to the suspension, are inherently capable of reducing the deposition of white pitch for the reasons previously discussed.

3. Claims 1-8, 10-11 and 13-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Humphreys et al (6103065).

Humphreys et al discloses a process for making paper comprising:

a). adding to the paper stock a cationic polymer in the amount of 0.005 to 0.25% followed by addition of

b) bentonite clay microparticles or colloidal silica in the amount of 0.025 to 2.0%  
(Abstract; col 4, lines 4-18; col 6, lines 30-31; col 7, lines 34-36).

The papermaking stock can contain recycled or waste pulp (col 6, lines 60-65).

The cationic polymer has a molecular weight from 100,000 to 2,000,000 (col 4, lines 7-10). The polymer can comprise one or more of cationic monomers of polyethyleneimines, diallyldimethyl ammonium halide, or polyvinylamine (col 4, lines 22-30; col 7, lines 5-12). The polymer can be copolymerized with acrylamide monomers (col 4, line 28). The bentonite is defined to include anionic swelling clays such as montmorillonite, hectorite, nontrite and beidellite (col 3, lines 41-45). Instead of the cationic polymer, other cationic inorganic materials can be used as coagulants for contaminants from waste paper (white pitch), such as polyaluminum chloride (col 6, lines 65-67; col 7, lines 1-13). Alum can also be added to the furnish (col 7, line 34). Although alum is added to adjust pH, it can also act as a coagulant. The amounts of addition of cationic polymer and bentonite overlap the amounts disclosed in the instant Specification on p 9, Examples 1 and 2 and on p 7, 2<sup>nd</sup> par from bottom.

The cationic polymer and bentonite disclosed by Humphreys et al ('775), when added to the suspension, are inherently capable of reducing the deposition of white pitch for the reasons previously discussed.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 1731

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Langley et al ('710) or Langley et al ('775).

Langley et al ('710) or Langley et al ('775) do not disclose paper products made by their processes; however, the abstract teaches a process for making paper and board using cationic polymers and anionic microparticles. It would have been obvious to one of ordinary skill in the art at the time of the invention to make paper using the disclosed process.

5. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Langley et al ('710) or Langley et al ('775) in view of Shimasaki et al (5262570).

Langley et al ('710) and Langley et al ('775) disclose the use of polyethyleneimines (or polyethylene polyamines) as suitable cationic polymers. Langley et al ('710) and Langley et al ('775) do not disclose that the cationic polymer is a polyalkelenepolyamine prepared by the reaction of an alkylene polyamine with a difunctional halide.

Shimasaki et al teaches that ethylenediamine reacts with ethylene dichloride to form diethylenetriamine and other ethyleneamine adducts, which are polyethylene polyamines (col 1, lines 11-21).

The art of Langley et al ('710), Langley et al ('775), Shimasaki et al and the instant invention are analogous as pertaining to the formation of polyalkylene

polyamines. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the reaction of an alkylene polyamine with a difunctional halide to form the polyalkylene polyamines for the cationic polymers in the process of Langley et al ('710) or Langley et al ('775) in view of Shimasaki et al as a well known process for making polyalkylene polyamines.

***Response to Arguments***

Applicant's arguments filed 5/12/2006 have been fully considered but they are not persuasive.

Applicant argues on pp 2 and 3 that the references do not disclose a pulp containing white pitch. The Langley references and the Humphreys references disclose the use of waste paper as a source of pulp. Applicants own disclosure reads, as quoted in the remarks, "waste paper includes coated waste, which ... gives rise to white pitch." Linhart et al (6303002) teaches that the reuse of fibers from waste paper results in stickies and white pitch in papermaking processes (col 1, lines 34-38). Shields et al (5786894) teaches that stickies are typically present to some degree in pulp produced from recycled paper (col 1, lines 52-57). Thus white pitch is inherently present in a papermaking process that makes use of recycled waste paper, such as the processes disclosed in the Langley and Humphreys references. As detailed above, the amounts of addition of the cationic polymers and the bentonite for the three references overlays or falls within the ranges disclosed in the instant Specification, thus must be effective amounts for reducing the deposition of white pitch. The cationic polymer and bentonite

disclosed by Langley et al ('710 or "775) or Humphreys et al ('775), when added to the suspension, are capable of reducing the deposition of white pitch because, where the claimed and prior art apparatus or product are identical or substantially identical in structure or composition, a *prima facie* case of either anticipation or obviousness has been established. *In re Best*, 562 F.2d 1252, 1255, 195 USPQ 430, 433 (CCPA 1977). In other words, when the structure recited in the reference is substantially identical to that of the claims, the claimed properties or functions are presumed to be inherent.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

} Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dennis Cordray whose telephone number is 571-272-8244. The examiner can normally be reached on M - F, 7:30 -4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
DRC

  
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